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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,739	02/09/2004	Dean A. Schaefer	1001.1386102	9215

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EXAMINER

VU, QUYNH-NHU HOANG

ART UNIT	PAPER NUMBER
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3763

MAIL DATE	DELIVERY MODE
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11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,739

Applicant(s)

SCHAEFER ET AL. c7

Examiner

Quynh-Nhu H. Vu

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation **“wherein eight axial members are uniformly spaced apart by 45° about the circumference to the shaft”** of claim 19; the limitation **“wherein the distal shaft portion has fewer axial members than the proximal shaft portion”** of claim 20 and the limitation **“wherein the distal shaft portion has one axial member selected from the plurality of axial members”** of claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification supports these limitations **“wherein eight axial members are uniformly spaced apart by 45° about the circumference to the shaft”** of claim 19; **“wherein the distal shaft portion has fewer axial members than the proximal shaft portion”** of claim 20 and the limitation **“wherein the distal shaft portion has one axial member selected from the plurality of axial members”** of claim 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-17, 20, 22, 24, 29-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster, Jr. (US 5,057,092).

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Webster discloses a catheter comprising: an elongate shaft having a reinforcement layer comprising a tubular braid having a first helical member 24 interwoven with a second helical member 26, and a plurality of axial members 28 disposed between the first helical member and the second helical member.

Regarding claim 17, the axial members are uniformly spaced about the circumference to the shaft.

Regarding claim 20, Webster discloses, in Fig. 1, the elongate shaft includes a proximal portion and a distal portion, and wherein the distal shaft portion has fewer axial members 28 than the proximal shaft portion.

Furthermore, It is noted that those skilled in the art will recognize that if an inner diameter of the proximal shaft is larger than an inner diameter of distal shaft portion will give the same result that the distal shaft portion has fewer axial members than the proximal shaft portion. For example, Head (US 6,148,865) is one of evidence shows that the distal shaft portion has fewer the axial members 22 the proximal shaft (see Fig. 3A); or Osborne (US 5,251,640) shows that the distal shaft portion has fewer the axial members 12 the proximal shaft (Figs. 1-5).

Regarding claims 22 and 24, the first and second helical members each comprise polymer material (col. 2, lines 54-65).

Regarding claim(s) 29-30, they encompass the same scope of the invention as to that of claims 1-2 except they are drafted in method format instead of apparatus format. The claim(s) is/are therefore rejected for the same reason as set forth above.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster, Jr. (US 5,057,092).

Regarding claims 18-19, as best as understood, Webster, Jr. discloses the claimed invention (see rejection above). Webster does not clearly disclose that four axial members are uniformly spaced apart by 90° about the circumference of the shaft; eight axial members are uniformly spaced apart by 45° about the circumference of the shaft. It would have been an obvious matter of design choice to provide the axial members as listed above, since applicant has not disclosed that the number of axial members spaced apart by 45° or 90° solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the device of Webster.

Regarding claims 20-21, as best as understood, Webster, Jr. discloses the claimed invention (see rejection above). Webster further discloses that the distal shaft portion has few number axial members than the proximal shaft portion. Webster does not clearly disclose that the distal shaft portion has one axial member selected from the plurality of axial member. It is noted that those skilled in the art will recognize that if an inner diameter of the proximal shaft is larger than an inner diameter of distal shaft portion will give the same result that the distal shaft portion has fewer axial members than the proximal shaft portion.

It would have been an obvious matter of design choice to provide the axial members as listed above, since applicant has not disclosed that the number of axial members solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the device of Webster.

Regarding claim(s) 31-32, they encompass the same scope of the invention as to that of claims 18-19 except they are drafted in method format instead of apparatus format. The claims are therefore rejected for the same reason as set forth above.

Claims 23 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster, Jr. (US 5,057,092) in view of Mortier et al. (US 5,730,733).

Webster, Jr. discloses the claimed invention (see rejection above). Webster does not disclose that the first and second helical members each comprise a plurality of monofilaments; wherein the monofilaments comprise LCP; the monofilaments are arranged side-by-side to collectively define a flat ribbon.

Mortier discloses that a first and second helical members 32 or 34 (Fig. 2A) each comprises a plurality of monofilaments 26, 36; wherein the monofilaments comprise LCP (liquid crystal polymer material), (col. 4, lines 18-30); the monofilaments are arranged side-by-side to collectively define a flat ribbon.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Webster with a plurality of monofilaments, as taught by Mortier, in order of increase the torsional rigidity and more flexible.

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent Nos. 6,709,429.

Claims 16, 22-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 6-9, 11, 13-28 of U.S. Patent Nos. 6,942,654.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the device and method of instant claims are fully disclosed and covered by the claims in the U.S. patents. 6,709,429 and 6,942,654.

Conclusion


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh-Nhu H. Vu whose telephone number is 571-272-3228. The examiner can normally be reached on 6:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Quynh-Nhu H. Vu
Examiner
Art Unit 3763



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